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REMARKS

Claims 1-33 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

In the Office Action, the Examiner has continued to indicate that claims 1-6, 12, 17 and 18 are allowed. The Examiner has also indicated that claims 11, 13-16, 19-24 and 27-31 have been allowed. Finally, the Examiner has indicated that claim 10 is in condition for allowance. The Applicants would like to thank the Examiner for those indications.

The Office Action has objected to the drawings under 35 U.S.C. §1.83(a) for not showing the relationship between the clip and the vertical frame member as claimed in claim 25. Applicants submit that all of the claim features of claim 25 are illustrated in Figs. 1 and 11. Notably, the clip 80 is shown in Fig. 1 having a pair of extensions 81 in the openings in the vertical member 18. Accordingly, Applicants submit that all of the elements of claim 25 are shown in the drawings.

Claims 25 and 26 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,178,702 to Hand et al. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of anticipation based upon the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Applicants respectfully assert that the Examiner has not yet met his burden of establishing a prima facie case of anticipation with respect to the rejected claims.

Claim 25 defines a partition frame including, among other things, a vertical frame member having opposite side faces, each side face including a vertical row of openings; a clip for routing and retaining utility lines along the vertical frame member, the clip including a pair of extensions extending inwardly towards one another and received within selected ones of the openings on the opposite side faces.

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The prior art of record does not disclose or suggest all of the above noted features of claim 25. Specifically, the prior art of record does not disclose or suggest a vertical frame member having opposite side faces, with each side face including a vertical row of openings and a clip including a pair of extensions extending inwardly towards one another and received within selected ones of the openings on the opposite side faces. The Hand et al. '702 patent includes a post 6 having slots 17. Furthermore, the Hand et al. '702 patent includes a change-of-height end cover 160 that includes slotted tabs 161. However, the slotted tabs 161 are not received within the slots 17 of the post 6. As stated in lines 18-21, the tabs engage cut-outs 162 of the post 6. Accordingly, the tabs 161 are not received within openings of the post 6. Accordingly, claim 25 is in condition for allowance. Furthermore, claim 26 depends from claim 25, and since claim 25 defines unobvious patentable subject matter as discussed above, claim 26 defines patentable subject matter. Therefore, claims 25 and 26 are in condition for allowance.

Claims 7-9 and 32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,023,896 to Rothschild in view of U.S. Patent Application Publication No. US 2002/0069601 A1 to Hodges et al. The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

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applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP §2143.01 provides further guidance as to what is necessary in showing that there was motivation known in the prior art to modify a reference teaching. Specifically, MPEP §2143.01 states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992); M.P.E.P. §2142. Applicants respectfully assert that the Examiner has not yet met the Examiner's burden of establishing a prima facie case of obviousness with respect to the rejected claims. Consequently, the Examiner's rejection of the subject claims is inappropriate, and should be withdrawn.

Claim 7 defines a partition including, among other things, a partition frame having a horizontally extending upper frame member defining an upper edge of the partition frame, the partition frame further including a pair of horizontally spaced apart vertical frame members, each defining a first cross-sectional shape and having an upper end thereof secured to the upper frame member, the partition frame having a lower portion configured to abuttingly support the partition frame freestanding on a floor surface; a horizontally extending raceway defining an elongated passageway configured to retain utility lines in a horizontally extending manner; and a vertically extending support member including a connector connected to the partition frame, the support member supporting the raceway vertically spaced above the upper frame member

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and defining a second cross-sectional shape that is different than the first cross-sectional shape. The prior art of record does not disclose or suggest the above-noted features of claim 7.

First, Applicants note that the present application has a filing date of October 20, 2000. The Hodges et al. '601 publication, while having an earlier priority date than the present application, was not published until after the filing date of the present application, namely on June 13, 2002. Accordingly, the Hodges et al. '601 publication could only be considered to be prior art under §102(e). However, both the Hodges et al. '601 publication and the present application have been assigned to Steelcase Development Inc. Therefore, the Hodges et al. '601 publication cannot be used in a §103(a) obviousness rejection of the present application under §103(c). Nevertheless, Applicants submit that the rejection is improper as discussed below.

In regard to the first criterion of obviousness, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references. The Rothschild '896 patent discloses a partition system configured to be wedged between a floor and a ceiling of a building. Notably, the Rothschild '896 patent includes a telescope adjustment mechanism as illustrated in Figs. 19A-19C to allow the partition system to fit within rooms of various heights. Accordingly, the Rothschild '896 patent teaches away from any freestanding utility panel system and a foot used in the panels wedged between a floor and ceiling of a room would therefore provide no advantage to the system disclosed in the Rothschild '896 patent. Accordingly, claims 7-9 are in condition for allowance.

Furthermore, in regards to the third criterion of obviousness, the prior art of record does not disclose or suggest a raceway that has a U-shaped cross section as claimed in claim 9. Although the Office Action states that Rothschild discloses a "cap (raceway) [that] has a U-shaped cross section," Applicants do not see any such U-shaped cross section in Fig. 1 as set forth in the Office Action. Furthermore, Applicants submit that the Rothschild '896 patent does not disclose any raceway that has a U-shaped cross section. Accordingly, claim 9 is in condition for allowance.

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Claim 32 defines a freestanding partition including, among other things, a partition frame having a horizontally extending upper frame member defining an upper edge of the partition frame, the partition frame further including a pair of horizontally spaced apart vertical frame members, each having an upper end thereof secured to the upper frame member, the partition frame having a lower portion configured to abuttingly support the partition frame freestanding on a floor surface; a horizontally extending raceway defining an elongated passageway configured to retain utility lines in a horizontally extending manner; and a vertically extending support member connected to the horizontally extending upper frame member of the partition frame at a location that is horizontally spaced from the vertical frame members and supporting the raceway on the upper frame member vertically spaced above the upper frame member.

The prior art of record does not disclose or suggest the above-noted features of claim 32. First, as discussed above, the Hodges et al. '601 publication is not prior art and there is no suggestion or motivation for combining the Rothschild '896 patent with the Hodges et al. '601 publication. Second, in regard to the third criterion of obviousness, even if there was a suggestion or motivation for combining the Rothschild '896 with the Hodges et al. '601 publication, any resulting combination would not include a vertically extending support member connected to a horizontally extending upper frame member of a partition frame at a location that is horizontally spaced from vertical frame members of the partition frame and supporting a raceway on the upper frame member vertically spaced above the upper frame member. Notably, the extension elements 52 are not spaced from the vertical frame elements 18 and 20 as disclosed in the Rothschild '896 patent. Accordingly, the rejection set forth in the Office Action does not include all of the features of claim 32. Furthermore, Applicants note that the Office Action has not specifically addressed 32 as required by 37 C.F.R. §1.104(c)(2). Accordingly, claim 32 is in condition for allowance.

Applicants note that claim 33 has not been objected to or rejected in the present Office Action. Accordingly, Applicants assume that claim 33 is in condition for allowance and a notice to such is respectfully requested.

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All pending claims 1-32 are believed to be in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.


Respectfully submitted,

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